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EXAMINER	
MENBERU, BENIYAM	
ART UNIT	**PAPER NUMBER**
2626	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/943,219	SUZUKI ET AL.	
	Examiner	Art Unit	
	Beniyam Menberu	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 April 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response to Arguments

1. Applicant's arguments, see pages 10-12, filed April 21, 2005, with respect to the rejection(s)of claim(s) 1 under U.S. Patent No. 5675421 to Ouchi in view of U.S. Patent No. 4638368 to Shimizu and claims 7-8 under U.S. Patent No. 5675421 to Ouchi in view of U.S. Patent No. 6434343 to Kobayashi and claim 10 under U.S. Patent No. 5675421 to Ouchi in view of U.S. Patent No. 6414759 to Ikegami have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of JP401318456A to Fukuda and U.S. Patent No. 5555104 to Todaka.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 4, 7, 8, 9, 10, 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 1, 7, 8, and 10 recites the limitation "the circuit" in line 2. There is insufficient antecedent basis for this limitation in the claim.

5. Claims 1, 7, 8, and 10 recites the limitation "the image data" and "the recording medium" in line 4, 5, 5, and 5 respectively. There is insufficient antecedent basis for this limitation in the claim.

6. Claims 7 and 8 recites the limitation "the functions" in line 7. There is insufficient antecedent basis for this limitation in the claim.

7. Claim 10 recites the limitation "the melody" in line 7. There is insufficient antecedent basis for this limitation in the claim.

8. Claims 4 and 11 recites the limitation "the setting of the setting means" in line 3 and lines 2-3 respectively. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 9 recites the limitations "the message", "the facsimile transmission", and "the telephone" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by JP401318456A to Fukuda.

Regarding claim 10, Fukuda disclose a communication terminal comprising: a network control unit for closing and releasing the circuit (page 7, lines 13-14, reference 233);

an operating key for making the network control unit release the circuit (It would be inherent that a hook key which reads on operating key is used to release the circuit of the facsimile system of Fukuda (page 7, lines 12-13));

a speaker (Since Fukuda discloses an alarm system it would be inherent that there is a speaker to output the alarm (page 7, lines 15-16));

a recording unit for recording the image data in the recording medium (page 7, line 10, reference 215); and

a control unit which refuses an incoming call by maintaining the state of closing the circuit with the network control unit and outputs the melody which indicates the closing of the circuit, from the speaker, in the case the recording unit fails to operate (page 7, lines 15-16; page 8, lines 18-21, reference 231; page 8, lines 15-17).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 1 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP401318456A to Fukuda in view of U.S. Patent No. 4638368 to Shimizu et al.

Regarding claim 1, Fukuda discloses a communication terminal comprising:

a network control unit for closing and releasing the circuit (page 7, lines 13-14, reference 233);

an operating key for making the network control unit release the circuit (It would be inherent that a hook key which reads on operating key is used to release the circuit of the facsimile system of Fukuda (page 7, lines 12-13));

a recording unit for recording the image data in the recording medium (page 7, line 10, reference 215);

a control unit which refuses an incoming call by maintaining the state of closing the circuit with the network control unit (page 7, lines 15-16; page 8, lines 18-21, reference 231). However Fukuda does not disclose a control unit that invalidates the operation and input of the said operating key in the case the recording unit fails to operate.

Shimizu et al disclose a communication apparatus that invalidates the operation and input of the said operating key in the case the recording unit fails to operate (column 6, lines 33-42).

Fukuda and Shimizu et al are combinable because they are in the similar problem area of facsimile transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine invalidation of operating key taught by Shimizu et al and the facsimile system of Fukuda to implement invalidation of operating key used for releasing the circuit during recording unit failure.

The motivation to combine the reference is clear because during recording failure it would be advantageous to prevent user from interfering with the operation of the facsimile machine so that the facsimile machine can recover from the failure (Shimizu et al: column 6, lines 33-37).

Regarding claim 18, Fukuda in view of Shimizu et al teach all the limitations of claim 1. Further Fukuda disclose a communication terminal according to claim 1 characterized in that the operating key for releasing the circuit is a hook key (page 7, lines 12-13).

14. Claims 2, 3, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP401318456A to Fukuda in view of U.S. Patent No. 4638368 to Shimizu et al further in view of U.S. Patent No. 5555104 to Todaka.

Regarding claim 2, Fukuda in view of Shimizu et al teach all the limitations of claim 1. However Fukuda in view of Shimizu et al does not disclose a communication terminal according to claim 1 comprising: an informing means for informing the fact that the operation of the said operating key is invalid.

Todaka discloses a communication terminal according to claim 1 comprising: an informing means for informing the fact that the operation of the said operating key is invalid (column 3, lines 27-30; column 4, lines 11-15, lines 15-23).

Fukuda, Shimizu et al, and Todaka are combinable because they are in the similar problem area of facsimile transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the informing apparatus of Todaka with the system of Fukuda in view of Shimizu et al to implement informing device for the status of the operating key.

The motivation to combine the reference is clear because a user needs to know the status of an operating key through the use of an informing device.

Regarding claim 3, Fukuda in view of Shimizu et al further in view of Todaka teach all the limitations of claim 2. Further Todaka disclose a communication terminal according to claim 2 characterized in that the fact that the operation is invalid is informed when the operating key is operated (column 5, lines 53-67).

Regarding claim 5, Fukuda in view of Shimizu et al teach all the limitations of claim 3. Further Shimizu et al disclose a communication terminal according to claim 3 characterized in that the informing means is a buzzer (column 6, lines 15-20).

Regarding claim 6, Fukuda in view of Shimizu et al teach all the limitations of claim 3. Further Shimizu et al disclose a communication terminal according to claim 3 characterized in that the informing means is the display (column 4, lines 37-40).

15. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP401318456A to Fukuda in view of U.S. Patent No. 6414759 to Ikegami et al.

Regarding claim 11, Fukuda teach all the limitations of claim 10. However Fukuda does not disclose a communication terminal characterized in that the control unit outputs from the speaker the said melody based on the setting of the setting means, further comprising: a setting means for setting whether or not the melody which indicates the closing of the circuit, to be output

Ikegami et al disclose a communication terminal characterized in that the control unit outputs from the speaker the said melody based on the setting of the setting means, further comprising: a setting means for setting whether or not the melody which indicates the closing of the circuit, to be output (column 3, lines 41-46. Since Ikegami et al disclose that the user has option to be notified of a disconnection either by display,

alarm sound or voice, Ikegami et al implies an option for setting the method of notification.).

Fukuda and Ikegami et al are combinable because they are in the similar problem area of facsimile transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the melody setting of Ikegami et al with the system of Fukuda to implement setting for melody for the closing of a circuit.

The motivation to combine the reference is clear because a user has option for the method of notification of a closing of the circuit.

16. Claims 14 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP401318456A to Fukuda in view of U.S. Patent No. 4638368 to Shimizu et al further in view of U.S. Patent No. 5675421 to Ouchi.

Regarding claim 14, Fukuda in view of Shimizu et al teach all the limitations of claim 1. However Fukuda in view of Shimizu et al does not disclose a communication terminal according to claim 1 characterized in that the control unit maintains the state of closing the circuit with the network control unit when the recording unit fails to operate and a image memory is overflowed, comprising: said image memory.

Ouchi discloses a communication terminal according to claim 1 characterized in that the control unit maintains the state of closing the circuit with the network control unit when the recording unit fails to operate and a image memory is overflowed, comprising: said image memory (column 11, lines 21-27).

Fukuda, Shimizu et al, and Ouchi are combinable because they are in the similar problem area of facsimile transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the communication terminal of Ouchi with the system of Fukuda in view of Shimizu et al to implement closing of circuit when recording unit fails and image memory is full.

The motivation to combine the reference is clear because when recording unit fails and image memory is full the facsimile needs to be shut down since either recording unit or image memory is needed to receive data.

Regarding claim 4, Fukuda in view of Shimizu et al teach all the limitations of claim 1. Further Ouchi disclose a communication terminal characterized in that the control unit makes the network control unit close the circuit according to the setting of the setting means in the case the recording unit fails to operate comprising: a setting means for setting whether or not the circuit is to be closed when the recording unit fails to operate (column 6, lines 40-57; The remote operation mode turned off determines setting of closing the circuit when recording and memory unit fails.).

17. Claims 7, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP401318456A to Fukuda in view of U.S. Patent No. 6434343 to Kobayashi et al.

Regarding claims 7 and 8, Fukuda discloses a communication terminal comprising:

a network control unit for closing and releasing the circuit (page 7, lines 13-14, reference 233);

an operating key for making the network control unit release the circuit(It would be inherent that a hook key which reads on operating key is used to release the circuit of the facsimile system of Fukuda (page 7, lines 12-13));

a recording unit for recording the image data in the recording medium (page 7, line 10, reference 215); and

a control unit which refuses an incoming call by maintaining the state of closing the circuit with the network control unit (page 7, lines 15-16; page 8, lines 18-21, reference 231). However Fukuda does not disclose an informing unit or a display unit for informing or displaying the functions capable of being used on the informing/display unit, in the case the recording unit fails to operate.

Kobayashi et al disclose an informing unit/display unit (column 10, lines 26-31) for informing or displaying the functions capable of being used on the informing/display unit in the case the recording unit fails to operate (column 11, lines 31-40).

Fukuda and Kobayashi et al are combinable because they are in the similar problem area of facsimile transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the informing unit/display of Kobayashi et al with the system of Fukuda to implement display of functions capable of being used.

The motivation to combine the reference is clear because a user needs to know the status of the communication terminal before use (Kobayashi et al: column 11, lines 31-40).

Regarding claim 9, Fukuda in view of Kobayashi et al teach all the limitations of claim 8. Further Kobayashi et al disclose a communication terminal according to claim 8 characterized in that the message which indicates that the facsimile transmission or the telephone is capable of being carried out, is displayed (column 13, lines 30-32).

18. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP401318456A to Fukuda in view of U.S. Patent No. 6434343 to Kobayashi et al further in view of U.S. Patent No. 5675421 to Ouchi.

Regarding claims 15 and 16, Fukuda in view of Kobayashi et al teach all the limitations of claims 7 and 8 respectively. However Fukuda in view of Kobayashi et al does not disclose a communication terminal characterized in that the control unit maintains the state of closing the circuit with the network control unit when the recording unit fails to operate and a image memory is overflowed, comprising said image memory.

Ouchi disclose a communication terminal characterized in that the control unit maintains the state of closing the circuit with the network control unit when the recording unit fails to operate and a image memory is overflowed, comprising said image memory (column 11, lines 21-27).

Fukuda, Kobayashi et al, and Ouchi are combinable because they are in the similar problem area of facsimile transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the closing of circuit when recording unit fails and image memory is full as taught by Ouchi with the system of Fukuda in view of Kobayashi et al.

The motivation to combine the reference is clear because when recording unit fails and image memory is full the facsimile needs to be shut down since either recording unit or image memory is needed to receive data.

19. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP401318456A to Fukuda in view of U.S. Patent No. 6434343 to Kobayashi et al further in view of U.S. Patent No. 6701095 to Fujimoto et al.

Regarding claim 12, Fukuda in view of Kobayashi et al teach all the limitations of claim 7. However Fukuda in view of Kobayashi et al does not disclose a communication terminal according to claim 7 characterized in that the functions capable of being used is informed in a voice message.

Fujimoto et al disclose a communication terminal characterized in that the functions capable of being used is informed in a voice message (column 31, lines 53-67).

Fukuda, Kobayashi et al, and Fujimoto et al are combinable because they are in the similar problem area of facsimile transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the voice messaging of capable functions of Fujimoto et al with the system of Fukuda in view of Kobayashi et al to enable users to hear messages related to the functions of the facsimile device.

The motivation to combine the reference is clear because voice message provides an alternative to informing users of the status of a facsimile machine.

20. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP401318456A to Fukuda in view of U.S. Patent No. 5675421 to Ouchi.

Regarding claim 17, Fukuda teaches all the limitations of claim 10. Fukuda discloses a communication terminal according to claim 10 characterized in that the control unit maintains the state of closing the circuit with the network control unit when the recording unit fails to operate. However Fukuda does not disclose a communication terminal according to claim 10 characterized in that the control unit maintains the state of closing the circuit with the network control unit when an image memory is overflowed, comprising: said image memory

Ouchi disclose a communication terminal characterized in that the control unit maintains the state of closing the circuit with the network control unit when an image memory is overflowed, comprising: said image memory (column 11, lines 21-27).

Fukuda and Ouchi are combinable because they are in the similar problem area of facsimile transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the closing of the circuit as taught by Ouchi with the facsimile system of Fukuda to implement circuit closing during memory full and when recording unit fails.

The motivation to combine the reference is clear because when recording unit fails and image memory is full the facsimile needs to be shut down since either recording unit or image memory is needed to receive data.

21. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP401318456A to Fukuda in view of U.S. Patent No. 6414759 to Ikegami et al further in view of U.S. Patent No. 6728534 to Izumi et al.

Regarding claim 13, Fukuda in view of Ikegami et al teach all the limitations of claim 11. However Fukuda in view of Ikegami et al does not disclose a communication terminal according to claim 11 characterized in that the circuit closing melody of which is different from the melody of the holding melody output when holding a telephone conversation, is output from the speaker.

Izumi et al disclose holding melody generator (Figure 2, reference 216) that generates melody during holding (column 9, lines 14-24). In combination with the system of Ikegami et al, the closing melody as set in Ikegami et al (for example using a voice) can be set differently than the holding melody as set by Izumi et al.

Fukuda, Ikegami et al, Izumi et al are combinable because they are in the similar problem area of facsimile transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the holding melody of Izumi et al with the facsimile system of Fukuda in view of Ikegami et al to implement different melody output during circuit closing and holding.

The motivation to combine the reference is clear because different melodies are necessary to inform user of different events.

Other Prior Art Cited

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5719619 to Hattori et al disclose bidirectional broadcasting method.

U.S. Patent No. 5128985 to Yoshida et al disclose communication system.

U.S. Patent No. 5778279 to Kawai et al disclose image forming apparatus.

U.S. Patent No. 6055067 to Matsuda et al disclose image processor with facsimile function.

U.S. Patent No. 6141695 to Sekiguchi et al disclose communication apparatus.

U.S. Patent No. 4920427 to Hirata disclose facsimile apparatus.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beniyam Menberu whose telephone number is (571) 272-7465. The examiner can normally be reached on 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (571) 272-2600. The group receptionist number for TC 2600 is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner

Beniyam Menberu

BM

08/05/2005

MARK WALLERSON
PRIMARY EXAMINER